

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Hideaki Watanabe

Application No.: 10/694,989

Group Art Unit: 2618

Filed: October 29, 2003

Examiner: Tuan Pham

For: COMMUNICATION DEVICE, AND METHOD AND COMPUTER PROGRAM FOR
INFORMATION PROCESSING THEREOF

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Attention: **MAIL STOP AF**
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

This is a "pre-appeal brief request for review" filed concurrently with a Notice of Appeal appealing final rejection of claims 1-7, 11-14, 17 and 18 in the October 30, 2009 final Office Action (FOA). The independent claims are 1, 4-5, 7, 11-14 and 17-18.

A pre-appeal brief panel review of below appealable issues is requested.

I. The independent claims 1, 4-5, 7, 11-14 and 17-18 are rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement.

The FOA states:

The newly added subject matter of "***storing profile information showing a connection procedure with said devices of the other party in said storage so that said profile information can be designated***" to independent claims 1, 4-5, 7, 11-14 and 17-18 are considered new matter because the specification as originally filed does not provide support for such limitation. Examiner has carefully reviewed the figure 4 of the application and it only describes a method of connection between the Bluetooth devices, not storing profile information showing a connection procedure with said devices of the other party in said storage so that said profile information can be designated (see Item 4 in the FOA).

In the previous response Applicant pointed out support for the amended subject matter in specification paragraphs 0056-0067, 0079-0100 and FIGS. 4, 7, and 11. To satisfy the written description requirement, a patent specification should describe the claimed subject matter in sufficient detail that one skilled in the art can reasonably conclude that the inventor had

possession of the claimed subject matter (see MPEP 2163-I). The Office Action provides 'carefully reviewed the figure 4 ... and it is only describe a method of connection between the Bluetooth device ...' However, Applicant also pointed out specification paragraphs 0056-0067, 0079-0100 and FIG. 11. For example, it is readily apparent that specification paragraphs 0082, 0089-0090, 0093, and 0098 describe in sufficient detail and convey with reasonable clarity to those skilled in the art that the Applicant had possession of the of subject matter, as follows:

For example, paragraph 0089 describes:

By the way, the communication terminal 2 having Bluetooth also ***records the corresponding profile information in the address book DB of the data base part 18*** at the same time, and may be set so that a user can designate a profile used when communicating with another communication terminal X. according to this, in each profile of Bluetooth, the two kinds of a side (a client) requiring a connection and a side (a server) required a connection are to exist (emphasis added).

Paragraph 0090 describes:

Further, this embodiment has a function that designates a profile used for a connection in relation to each Bluetooth which is registered, in the address book DB constituted by the data base part 18. The connection selecting part constituted by the control part 16 is constituted so that the connection selecting part retrieves the address book DB by using a person's name selected by a user as a key, ***determines a profile used for a connection in the above-mentioned profile designation when starting Bluetooth communication by using a Bluetooth device address obtained from that retrieval, and connects by a procedure according to that profile*** (emphasis added).

These descriptions in sufficient detail and with reasonable clarity describe the claim 1 subject matter "***storing profile information showing a connection procedure with said devices of the other party in said storage so that said profile information can be designated.***" Using claim 1 as an example, the Office Action includes a clear deficiency or errs by failing to establish a prima facie case of lack of written description of claim 1, because the Office Action does not present by a preponderance of evidence reasoning that explains why persons skilled in the art would not recognize in the disclosure a description of the claim 1 recitation "***storing profile information showing a connection procedure with said devices of the other party in said storage so that said profile information can be designated.***"

For the reasons discussed above, the Office Action includes a clear deficiency in the prima facie case in support of the written description rejection by failing to present by a preponderance of evidence why a person skilled in the art would not recognize in the applicant's

disclosure a description of the above subject matter of claim 1 (see MPEP 2162-II and III). In addition, for the reasons discussed above, it is clear that the above subject matter of other independent claims 4-5, 7, 11-14 and 17-18 comply with the written description requirement under 35 U.S.C. 112, first paragraph, and withdrawal of the rejection is requested.

II. Claims 1-6, 11-14 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huuskonen (US 2004/0078372) in view of Aholainen et al. (US 7,102,640) and further in view of Nyman et al. (US 7,089,298).

Independent claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huuskonen in view of Hama et al. (US 2002/0039915) and further in view of Nyman.

To establish a prima facie case of obviousness Huuskonen, Aholainen, Nyman and Hama must disclose, either expressly or implicitly, the language of a claim. Using claim 1 as an example, the Office Action obviousness rejection of independent claim 1 over Huuskonen, Aholainen and Nyman has a clear deficiency in the prima facie case in support of the obviousness rejection, because:

(i) The FOA, item 6, states:

Regarding claim 1, Huuskonen teaches a communication device (see figure 1, WCD 102) ... storing profile information showing a connection procedure with said devices of the other party in said storage so that said profile information can be designated (see explain above, [0110-0121])" (see Item 6, page 5 line 20-page 6 line 5 in the FOA).

However, paragraph 0120 in Huuskonen discusses:

Also, in Bluetooth, such higher level sessions may include a Service Discovery Protocol (SDP) searching function, where a requesting device (such as WCD 102) learns the services offered by an encountered remote device.

Paragraphs 0110-0120 of Huuskonen discuss an inquiry process and a paging process between two Bluetooth devices before data exchange, namely paragraph 120 discusses that by a protocol of SDP, a requesting device learns the services offered by an encountered remote device. In other words, Huuskonen does not disclose a profile or an arrangement of how a protocol is used for providing/using a service, namely **"profile ... showing a connection procedure."** The language of claim 1 explicitly has **"profile ... showing a connection procedure,"** which Huuskonen does not expressly disclose. The Office Action includes a clear deficiency or errs by not providing any evidence in support of Huuskonen implicitly disclosing this feature in support of the obviousness rejection.

Nothing has been found or cited in Huuskonen's discussions of the inquiry and paging process, that it would be obvious to one skilled in the art to modify Huuskonen's inquiry or paging process to provide the claimed **"profile ... showing a connection procedure ... said profile information can be designated ... said connection being performed by a procedure according to the said profile information."**

(ii) FOA acknowledges that Huuskonen and Aholainen do not disclose **"profile ... showing a connection procedure ... said profile information can be designated ... said connection being performed by a procedure according to the said profile information,"** namely the FOA, page 7 provides: 'Huuskonen and Aholainen, in combination, fails to teach ... said connection being performed by a procedure according to said profile information to be designated.' Therefore, the FOA relies upon Nyman and states:

However, Nyman teaches...said connection being performed by a procedure according to said profile information to be designated (see figure 1g, col. 12, ln. 1-15, device 116 store the name of wireless device 100 and the device address 100 in the record 236 of device 116. When Dan select the Alice's name to send the message to Alice's device 100 that will retrieve the Alice's device address in the memory for transmitting the message to Alice's device). (see Item 6, page 7 line 12-page 8 line 5 in the FOA)

However, column 11 lines 66-column 12 line 15 in Nyman discusses:

For example, the four users in Fig.1 may be running a distributed program, such as game 95 shown in Fig. 1G, in which messages 97 are exchanged between the players as a part of the game. When the Alice's name is displayed in the browser of Dan Jones' wireless device 116 during the course of the game, the access code for Alice's device 100 is associated with the display of the Alice's name, such as by means of a hyperlink displayed with her name 86 on Dan's device 116. Name records 236 for each of the wireless devices 100, 108, 114, and 116 in the ad hoc network 132' are stored in Dan's device 116. When Dan Jones selects Alice's name 86 displayed by the browser 211 in his device 116, Alice's access code ADDRESS(A) is accessed from her name record 236 stored in Dan's device 116. Alice's access code is appended to a message 97, which has been prepared by Dan, and the message is automatically sent to Alice's device 100 where it is received as message 97'.

In other words, Nyman, column 11, line 66-column 12, line 15 merely disclose that when Alice's name 86 displayed by the browser 211 in Dan's device 116 is selected, Alice's access code is accessed. Nyman does not disclose, either expressly or implicitly, that **"said connection"** is **"performed by a procedure according to said profile information to be designated."** In other words, Nyman does not disclose a profile or an arrangement of how a protocol is used for providing/using a service, namely fails to disclose **"profile ... showing a**

connection procedure." Nyman's access code cannot expressly meet the language of claim 1 explicitly emphasizing "**profile ... showing a connection procedure.**" The Office Action includes a clear deficiency or errs by not providing any evidence in support of Nyman implicitly disclosing this feature in support of the obviousness rejection.

In other words, nothing has been found or cited in Nyman's discussions in column 11, line 66-column 12, line 15, that it would be obvious to one of ordinary skill in the art to modify Nyman's discussion of Alice's access code to provide the claimed "**profile ... showing a connection procedure ... said profile information can be designated ... said connection being performed by a procedure according to the said profile information**" and then combine Nyman as modified with Huuskonen and Aholainen to provide the language of claim 1.

In addition, Hama is relied upon to reject the feature relating to use of "proper address information," so it is readily apparent that Hama does not cure the deficiencies of Huuskonen, Aholainen and Nyman.

(iii) In addition, a prima facie case of obviousness has not been properly established, because the Office Action clearly omits a reasonable broadest interpretation under 37 CFR 1.56 by preponderance of evidence of Huuskonen's inquiry and paging process between two Bluetooth devices and Nyman's Alice's access code for meeting the claimed "**profile ... showing a connection procedure with said devices of the other party ... so that said profile information can be designated**" and "**said connection being performed by a procedure according to said profile information to be designated.**"

For the reasons (i), (ii) and (iii), the obviousness rejection of claim 1 over Huuskonen, Aholainen and Nyman includes a clear deficiency and cannot be maintained.

Dependent claims inherit the features of independent claims. Other independent claims have limitations similar to the discussed limitations of claim 1. Withdrawal of the obviousness rejections is requested.

Please charge account 19-3935 for any fees deficiency.

Respectfully submitted,
STAAS & HALSEY LLP
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